

REMARKS

Applicants appreciate the Examiner's thorough review of the present application, and respectfully request reconsideration in light of the preceding amendments and the following remarks.

Claims 1, 3-5, 7-13, and 15-23 are pending in the application. Claims 2 and 6 have been cancelled without prejudice or disclaimer. The remaining original claims have been amended to better define the claimed invention. New claims 18-23 have been added to provide Applicants with the scope of protection to which they are believed entitled. No new matter has been introduced through the foregoing amendments.

The 35 U.S.C. 103(a) rejection of claims 1-17 as being obvious over *Robles* is believed overcome in view of the above amendments.

In particular, independent claim 1 has been amended to additionally recite that "each said side flap is fixed to said diaper body at a fixing part and a joint part, said fixing part being arranged adjacent and along an inner edge of the inner end of the respective side flap, the joint part being arranged adjacent and along the respective side edge of the diaper body, and said fixing part being spaced in the width direction of said diaper body from said joint part by a bonding-free region." The added feature finds support in at least the original drawings, e.g., FIG. 3, where it is disclosed that fixing part 32 is arranged adjacent and along an inner edge (phantom line) of inner end 34 of side flap 14, that joint part 35/36 are arranged adjacent and along the respective side edge (20, FIG. 1) of the diaper body, and that a bonding-free region (between 35 and 32 and/or between 36 and 32) is located between associated joint part 35/36 and fixing part 32.

Robles does not fairly teach or suggest the added claim limitation. As can be seen in FIG. 1 of *Robles*, edges 80 along which the side panels 30 are bonded to the containment assembly 22 are not spaced from each other in the width direction by a bonding-free region, as presently claimed.

The Examiner's argument found in the Office Action, at page 3, lines 3-10 from bottom is noted. Basically, the Examiner argues that since side panels 36, 38 (FIG. 1) of *Robles* can be bonded to the containment assembly 22 in a number of different ways, one of the fixing part and joint part can be located inwardly of the other. Applicants respectfully disagree, because

[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (emphasis added), cited in *MPEP*, section 2143.01.III.

The Examiner's suggestion or motivation to modify *Robles* found in the Office Action, at page 3, lines 3-6 from bottom is also inadequate, because it has failed to specify any reason why a person of ordinary skill in the art would have made the proposed modification, i.e., for what benefit.

Finally, Applicants respectfully submit that the *Robles* broad teaching that the bonding can be made in different ways is merely an invitation to experiment, and does not suggest the desirability of the claimed invention.

For any of the reasons advanced above, Applicants respectfully submit that amended claim 1 is patentable over *Robles*, and request that the 35 U.S.C. 103(a) rejection be withdrawn.

Claims 3-5, 7-13, and 18-23 depend from claim 1, and are considered patentable at least for the reasons advanced with respect to amended claim 1. The dependent claims are also patentable on their own merits since these claims recite other features of the invention neither disclosed, taught nor suggested by the applied art.

Independent claims 15-17 are believed patentable over the applied reference of *Robles* for at least the reason advanced in the previous Amendment, at page 10, the first full paragraph, i.e., *Robles* teaches providing better fit by having extensible side panels rather than by adjusting a length (claim 15), a width (claim 16), or a position (claim 17) of the first and second joint parts, as presently claimed. In addition, the reference is silent on whether the attachment of edges 80 to the

outer surface of backsheet 26 or the inner surface of topsheet 24 would at all have any fitting effect. Therefore, a person of ordinary skill in the art learning of the *Robles* teaching that extensible side panels provide better fit, would have been motivated, if at all, only to modify the extensibility of the side panels, rather than their bonding to the assembly 22, in order to improve fitting of the garment. Thus, the person of ordinary skill in the art would not have modified *Robles* in the Examiner's proposed manner if enhanced fit is desired.

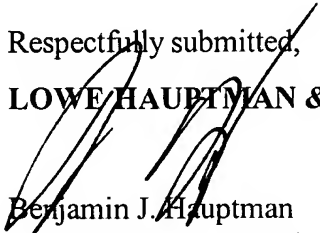
Each of the Examiner's rejections has been traversed. Accordingly, Applicants respectfully submit that all claims are now in condition for allowance. Early and favorable indication of allowance is courteously solicited.

The Examiner is invited to telephone the undersigned, Applicant's attorney of record, to facilitate advancement of the present application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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